

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on December 2, 2004. Claims 1 and 3-9 are pending in the Application and stand rejected.

Applicants respectfully bring to the attention of the Examiner that the IDSs filed on this Application on March 22, 2004 and February 6, 2004 have not been acknowledged. If necessary, Applicants are in a position to resubmit copies of those IDSs and the date-stamped filing receipt, documenting that the IDS was properly filed on that date. Applicants respectfully request the Examiner to inform Applicants' representatives at the earliest convenient time about the need to resend copies of the IDS filing documents.

Summarizing the outstanding Office Action, the amendment filed on April 22, 2004 was objected to under 35 U.S.C. § 132 for allegedly introducing new matter. Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art FIG. 7 of Applicants' specification (hereinafter "prior art FIG. 7"). Claims 1 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art FIG. 7 in view of Saito (Japanese Unexamined Utility Model Publication No. 63-104982, hereinafter "Saito"). Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art FIG. 7 in view of Saito and further in view of Sera and Nakamura (Japanese Patent Publication No. 60-058270, hereinafter "Sera"). Claims 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art FIG. 7 in view of Saito and Sera. Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art FIG. 7 in view of Saito. Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art FIG. 7 in view of Saito, and further over Sera.

As to the objection under 35 U.S.C. § 132, Applicants respectfully submit that the Amendment filed on April 22, 2004 does not introduce new matter into this application. The

subject matter recited in Claims 1, 5, 8, and 9 is clearly disclosed in FIG. 3 of Applicants Specification.¹ In FIG. 3 a range of draw forming positions between 0 and 20% is clearly disclosed. Claims 1, 5, 8, and 9 were amended on April 22, 2004 to recite a sub range within the range originally disclosed. The specific mentioning of 10% in the discussion on pages 8 and 9 of Applicants' specification was to illustrate that the door panel 3 gets reinforced the most with the least amount of displacement when the draw forming is provided at a position of approximately 10% as illustrated by the approximate curve in that figure. However, the experimental data point between 14 and 16% clearly shows a result that, neglecting experimental errors, is lower than the maximum amount of displacement obtained at 10% draw forming position. However, a maximum amount of displacement is NOT what is recited in Claims 1, 5, 8, and 9. Those claims recite a sub range of the range disclosed in FIG. 3. Based at least on the above-summarized reasons, Applicants respectfully request reconsideration of the objection under 35 U.S.C. § 132.

As to the rejection of Claim 1 as being obvious in view of prior art FIG. 7, Applicants respectfully submit that prior art FIG. 7 does not support a *prima facie* case of obviousness of the invention recited in Claim 1 because the reference does not teach or suggest all the claimed features.

According to a feature of the invention as set forth in Claim 1, a door for a refrigerator is recited, comprising, among other features, draw forming provided at a position near an edge of either side of the door panel at a position away from the edge at approximately between 4 and 16% of a full width of the door panel such that a metal sheet for keeping the door panel from warping or getting uneven is not required.

Prior art FIG. 7 discloses a fridge door having a metal sheet placed between a door panel 3 and heat insulating foam material in order to prevent the door from getting uneven

¹ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

due to thermal shrinkage or expansion of the insulating foam material. Prior art FIG. 7 is silent with respect to any draw forming being provided in the disclosed door, contrary to what is recited in Claim 1. In addition, prior art FIG. 7 discloses a metal sheet, which element is expressly excluded from Claim 1. As such, prior art FIG. 7 cannot support a *prima facie* case of obviousness of Claim 1 for several reasons.

First, all the limitations are not taught or disclosed by the reference as just explained. The outstanding Office Action recognizes that prior art FIG. 7 does not contain a discussion regarding an amount of draw forming, but concludes that it would be obvious to one of ordinary skill in the art to select a known draw forming percentage according to the use intended as an obvious matter of design choice. Applicants respectfully disagree with such an unsubstantiated conclusion.

The Office states that “the amount of draw forming determines how much of the remainder of the panel will curve. The curve further determines how much insulation the panel will curve.” However, Applicants specification is silent with respect to either the amount of curvature a door will experience as a function of the amount of draw forming provided or an ability to use more or less insulation as a function of the amount of draw forming provided. Claim 1 does not recite an amount of draw forming, but simply the location in the door panel where draw forming is provided with respect to the total width of that panel (see, for example, FIG. 2 of Applicants’ specification).

Applicants invention is concerned with the amount of maximum deflection experienced by a given amount of insulation inside a door fridge provided with draw forming at the location as claimed in order to eliminate, or significantly reduce, the thermal shrinking or expansion problems outlined in Applicants’ specification.² There is nothing in either of the applied references or in the body of knowledge generally available to one of ordinary skill

² See, for example, Specification, page 2, lines 2-12.

in the art that supports the proposition set forth by the Office. A factual issue such as this must be supported by “substantial evidence” under the Administrative Procedures Act.³ The outstanding Office Action is devoid of any evidence, let alone substantial evidence, in support of the unsubstantiated conclusion related to the obviousness rejection of Claim 1. Therefore, Applicant requests that such substantial evidence be provided or that the rejection of Claim 1 be withdrawn.

Second, even if assuming *in arguendo* that prior art FIG. 7 does disclose a door provided with draw forming, no disclosure or teaching of the critical location of the recited placement of the draw forming is found in prior art FIG. 7. In addition, the door of the present invention does not comprise a metal sheet because of the advantageous placement of the draw forming provided therein. Provision of the structural draw forming to a fridge door as recited in Claim 1 advantageously enable the elimination of a needed element in the prior art, while at the same time retaining its function—a clear indicia of unobviousness.⁴

Thirdly, the outstanding Office Action asserts that the limitation “draw forming” is a method limitation on an apparatus claims and that no patentable weight should be given to an apparatus claim containing a method step. Applicants respectfully disagree with both assertions. First, the limitation of draw forming being provided in the door is structural and not a process limitation. However, even if assuming *in arguendo* that Claim 1 is a product-by-process-type claim, as clearly stated in the MPEP § 2113, patentable weight must be given to structural features resulting from the method steps.⁵

³ *Dickenson v. Zurko*, 119 S. Ct. 1816, 50 USPQ 2d 1930 (1999); *In re Gartside*, 53 USPQ 2d 1769 (Fed. Cir. 2000).

⁴ “Note that the omission of an element and retention of its function is an indicia of unobviousness.” See MPEP §2144.04(II)(B), citing *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966), emphasis in original.

⁵ The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding “interbonded by interfusion” to limit structure of the claimed composite and noting that

Therefore, based at least on the foregoing reasons, Applicants submit that prior art FIG. 7 does not make obvious the invention recited in Claim 1. Withdrawal of the rejection of Claim 1 under 35 U.S.C. § 103(a) in view of prior art FIG. 7 is respectfully requested.

With regard to the other obviousness rejections of Claims 1 and 3-9 based on the combination of prior art FIG. 7 with Saito and/or Sera, Applicants respectfully submit that prior art FIG. 7, Saito, and Sera, neither individually nor in any combination thereof, support a *prima facie* case of obviousness of the invention recited in Claims 1, 5, 8, and 9. This is so because, even when combined, these references do not teach or suggest all the claimed features.

Claim 1 and the deficiencies of prior art FIG. 7 as applied thereto have already been discussed above.

Claim 5 recites, among other features, a door for a refrigerator having a draw-formed door panel wherein draw forming is provided at a position away from the edge at approximately between 4 and 16% of a full width of the draw-formed door panel such that a metal sheet for keeping the door panel from warping or getting uneven is not required.

Claims 8 and 9 recite methods for producing a door for a refrigerator, comprising, among other features, a step of draw forming the door panel at a position away from the edge at approximately between 4 and 16% of a full width of the door panel such that a metal sheet for keeping the door panel from warping or getting uneven is not required.

In the rejection of Claims 1 and 3 based on the combination of prior art FIG. 7 and Saito, the Examiner cites Saito as disclosing that it is known in the art to form a door panel 4a with draw forming as at (4) in figures 1 and 2. However, Saito is silent as to positioning the provided draw forming at the recited position as well as to a door lacking a metal sheet for keeping the door panel from warping or getting uneven. Thus, Saito does not remedy the

terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.).

above-noted deficiencies of prior art FIG. 7. In the outstanding Office Action, similar arguments are proposed for the combination of prior art FIG. 7 and Saito as the ones advanced in the rejection based only in prior art FIG. 7. Applicants resubmit the previously presented arguments in reply.

Therefore, based at least on the foregoing, prior art FIG. 7 and Saito, neither individually nor in any combination thereof, make obvious the invention recited in Claim 1. In addition, Claims 3 should be allowed, among other reasons, as depending either directly or indirectly from Claim 1, which should be allowed as just explained. For the foregoing remarks, Applicants respectfully request withdrawal of the rejection of Claims 1 and 3 under 35 U.S.C. § 103(a) in view of prior art FIG. 7 and Saito.

As to the rejection of Claims 4, 5, and 7 over prior art FIG. 7, Saito, and Sera, Sera was cited for disclosing a two-tone coloring panel. Claims 1 and 5 have already been summarized above. However, Sera is silent as to positioning the provided draw forming at the recited position as well as to a door lacking a metal sheet for keeping the door panel from warping or getting uneven. Thus, Sera does not remedy the above-noted deficiencies of prior art FIG. 7 and Saito.

Therefore, for the reasons just summarized, prior art FIG. 7, Saito, and Sera, neither individually nor in any combination thereof, make obvious the invention recited in Claims 1 and 5. In addition, Claims 4, 6, and 7 should be allowed, among other reasons, as depending either directly or indirectly from Claims 1 or 5, respectively, which should be allowed as just explained. Applicants respectfully request withdrawal of the rejection of Claims 4, 5, and 7 under 35 U.S.C. § 103(a) in view of prior art FIG. 7, Saito, and Sera.

As to the rejection of Claims 8 and 9 over prior art FIG. 7 and Saito (Claim 8), and prior art FIG. 7, Saito, and Sera (as applied to Claim 9), as already explained herein above, none of the cited references disclose a method of producing a door without a metal sheet for

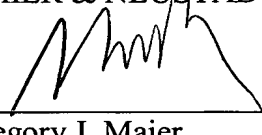
keeping a door panel from warping or getting uneven in view of a step of draw forming the door panel at a position away from the edge at approximately between 4 and 16% of a full door panel. The reasons for combining prior art FIG. 7 and Saito were the same as the ones previously discussed and traversed hereinabove and will not be repeated here, but are incorporated herein by reference in its entirety. However, for the reasons already presented, Applicants respectfully submit that prior art FIG. 7, Saito, and Sera, neither individually nor in any combination thereof, make obvious the invention recited in Claims 8 and 9. Thus, Applicants respectfully request withdrawal of the rejection of Claims 8 and 9 under 35 U.S.C. § 103(a) in view of over prior art FIG. 7 and Saito (Claim 8), and prior art FIG. 7, Saito, and Sera (as applied to Claim 9).

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1 and 3-9 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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